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REMARKS/ARGUMENTS

In the application, claims 1-28 remain pending. The applicants' disclosure describes a novel ceiling panel that is designed to create a moiré pattern on the panels when viewed from below. The moiré panels are fabricated out of a variety of materials including, but not limited to, metal, polymer and fiberglass. The moiré panel may be comprised of a translucent lower layer, a translucent upper layer and a light diffusing layer. The lower layer includes a surface with a plurality of openings or light passable regions that allow light to pass through and is adapted to be connected to a ceiling grid. The upper layer also includes a plurality of openings or light passable regions that allow light to pass through and is adapted to be connected to the lower layer. The light diffusing layer is positioned above the upper layer and is designed to intensify the moiré pattern while simultaneously concealing the area above the panel. The lower layer and upper layer are placed into the grid to form the panel. In one embodiment, the moiré panels are designed to be inserted into and suspended from a ceiling grid system.

35 U.S.C. §103 Rejections

In the Office Action, claims 1, 10 and 15 were rejected to under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 3,460,299 to Wilson. According to the Action, Fig. 1 and column 2, lines 9-31, disclose a ceiling panel having a first layer 9 with a plurality of openings distributed throughout the layer to allow light to pass through and a second layer 10 attached to the first layer 9 by metal channel 11. The Office Action further states that the second layer is adapted to allow light to allow light to pass through and the first layer is spaced apart from the second layer.

Upon reviewing column 2, lines 9-31, no such recitation is made. Column 2, lines 9-31, state that each light transmitting panel have a rigid window frame supportable by a grid and

proceeds to discuss the thickness of the window frames. There is no discussion of a ceiling panel having a first layer with a plurality of openings distributed substantially throughout its surface and such arrangement is clearly not shown in Fig. 1.

In column 1, lines 55-63, Wilson states that the purpose of the luminescent ceiling panels is to diffuse light from fluorescent or other light sources so as to provide overall high intensity illumination without objectionable glare or contrast. To accomplish overall high intensity illuminations, the panels are made from a translucent material, which diffuses the light and prevents bright spots. Since the purpose of the Wilson panel is to create overall high intensity illumination, an opaque layer could not be used since the opaque layer would block light, reducing intensity, and defeating the intended purpose of the panel.

In the Office Action, it is stated that Wilson does not contain an opaque layer. It is stated that it would have been obvious to provide the first layer as opaque, since Wilson discloses that at least one layer is translucent. Contrary to the position taken in the Office Action, the second layer would be clear and not opaque because an opaque layer would teach away from the intended purpose of the Wilson panel. It is respectfully submitted that there is no suggestion, teaching or motivation to modify the cited references in a way to arrive at applicant's claimed invention.

Numerous cases which have been decided by the Federal Circuit state the proposition that there must be a teaching or suggestion in the cited references to modify them as suggested by the Examiner. See, for example, Ben W. Vandenberg et al. v. Dairy Equipment Co., 224 U.S.P.Q. 195 (Fed. Cir. 1984).

The issue of obviousness or non-obviousness was discussed in an opinion of the Federal Circuit entitled Orthopedic Equipment Co., Inc. v. U.S., 217 U.S.P.Q. 193 (Fed. Cir. 1983). The

Federal Circuit noted that the question of non-obviousness is a simple one to ask, but difficult to answer. There the Court was confronted with a situation in which the prior art showed each of the elements of the disputed claims. The question, the Court said, becomes whether it would have been obvious to a person of ordinary skill in the art to “coordinate” these elements in the same manner as the disputed claims. In cautioning against the use of hindsight in answering this question, the Court stated at page 199:

“The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law”.

In re Rijckaert, 28 U.S.P.Q. 2(d) 1955 (CAFC 1993) the Court of Appeals outlined the burden on the Patent and Trademark Office as follows:

“In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. In *re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. *Id.* “A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.” In *re Bell*, 991 F.2d 781, 782, 26 USPQ2d 1529, 1531, (Fed. Cir. 1993) (quoting in *re Rinehart*, 531 F. 2d 1048. 1-51, 189 U.S.P.Q. 143, 147, (CCPA 1976)). If the Examiner fails to establish a *prima facie* case, the rejection is improper and will be overturned. In *re Fine*, 837 F. 2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).”

There is no objective teaching in Wilson to suggest that the first layer is an opaque layer and doing so would teach away from the intended purpose of the luminescent panels. Only Applicant’s specification and drawings provide that teaching.

More recently, the Federal Circuit gave additional guidance when rejecting claims as obvious over a combination of prior art references. The Court in re Dembiczak, 50 USPQ2d 1614 (1999) reversed a rejection of claims as obvious over a combination of prior art references.

The Court stated at page 1616:

“Our analysis begins in the text of section 103 quoted above, with the phrase “at the time the invention was made.” For it is this phrase that guards against entry into the “tempting but forbidden zone of hindsight,” see *Loctite Corp. v. Ultraseal, Ltd.*, 781 F. 2d 861, 873, 228, USPQ 90, 98, (Fed. Cir. 1985), overruled on other grounds by *Nobelpharma AB v. Implant Innovations, Inc.*, 141 F.3d 1059, 46 USPQ2d 1097 (Fed. Cir. 1998), when analyzing the patentability of claims pursuant to that section. Measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See e.g., *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313, (Fed. Cir. 1983). Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one “to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher”. *Id.*

Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. See, e.g. *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232, (Fed. Cir. 1998) (describing “teaching or suggestion or motivation [to combine]” as an “essential evidentiary component of an obviousness holding”); *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) (“the Board must identify specifically.... the reasons one of ordinary skill in the art would have been motivated to select the references and combine them”); *In re Fritch*, 972 F. 2(d) 1260, 1265, 23 USPQ2d 1780, 1783, (Fed. Cir. 1992) (examiner can satisfy burden of obviousness in light of combination “only by showing some objective teaching [leading to the combination]”); *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) (evidence of teaching or suggestion “essential” to avoid hindsight); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.* 776 F.2d 281, 297, 227 USPQ 657, 667 (Fed. Cir.

1985) (district court's conclusion of obviousness was error when it "did not elucidate any factual teachings, suggestions or incentives from this prior art that showed the propriety of combination"). See also *Graham*, 3838 U.S. at 18, 148 USPQ at 467 ("strict observance" of factual predicates to obviousness conclusion required). Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability - the essence of hindsight. See, e.g., *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985) ("The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time."). In this case, the Board fell into the hindsight trap.

Also see *Ecolochem, Inc. v. Southern California Edison Company* 227 F.3d 1361 (Fed.

Cir. 2000) which held at page 1375 that:

"However, there still must be evidence that "a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed."

In re Rouffet, 149 F.3d at 1357, 47 USPQ2d at 1456; see also In re Werner Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("[A] rejection cannot be predicated on the mere identification....of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.") Here, there was no such evidence presented."

Thus, since there is no teaching that one of the layers of Wilson is opaque, claims 1, 10 and 15 are not anticipated or rendered obvious by the '299 Wilson reference.

In the Office Action, claims 2-5, 11-24 and 16-19 were rejected under 103(a) as being unpatentable over Wilson in view of the '073 Schwartz reference. According to the Office Action, Wilson discloses the claimed invention except the translucent layer coated with an opaque film. The Office Action further states that Schwartz in column 2, lines 44-47, the

translucent ceiling panel is coated with an opaque coating and it would have been obvious to coat the ceiling panel with opaque in order for light to reflect more strongly.

The purpose of the opaque coating of the present invention, as disclosed in claims 2-3, 11-12 and 16-17, is to block light and not reflect light. The purpose of blocking light in regions of the panel is so that light only passes through the clear portions of the panel to trick the human eye into seeing a moiré pattern. There is no teaching in Schwartz that the surface includes coated and uncoated areas wherein the uncoated areas are adapted to allow light to pass through. After reviewing the Schwartz reference, it is the sidewalls 17 that are uniformly coated and not the top of the panel.

The top of the wall 17 of Schwartz is a uniformly coated surface and does not permit any light to pass through. Column 2, lines 44-51 of Schwartz states that the surface of the walls facing the ceiling are painted with an opaque coating so that light only illuminates through the top layer 14. There is no teaching in Schwartz that the top layer 14 includes an opaque coating. Further, even if such a teaching were disclosed in Schwartz, the coating would not be applied to Wilson since applying an opaque coating would defeat the intended purpose of Wilson, which is to diffuse and not block light. Thus, the combination of Wilson in view of Schwartz does not anticipate or render obvious claims 2-5, 11-14 and 16-19.

Claims 26-27 were rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson in view of U.S. Patent No. 4,941,074 to DeCosse et al. DeCosse et al. discloses a light box having a housing 11 or shell and includes a film 13 positioned within the box 11 that is highly reflective. The film 13 acts as a mirrored surface and does not have light blocking and light passable regions. In fact, the light never passes through the film 13 or the housing 11. The light only passes through a conventional light diffusing layer 12. Combining DeCosse with Wilson does

not arrive at Applicant's claimed invention. Use of the film 13 of DeCosse with Wilson teaches away from the purpose of Wilson, which is to diffuse light from fluorescent lighting. Thus, the combination of DeCosse with Wilson does not anticipate or render obvious claims 26 and 27.

35 U.S.C. 102 Rejections

Claims 20-23 were rejected under 35 U.S.C. 102(b) as being anticipated by Wilson. As can be seen, the claimed invention has several distinctions and limitations that are not shown in (or even suggested by) Wilson. Of course, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference *Verdegaak Bros. v. Union Oil Co. of California*, 2 U.S.P.Q. 2(d) 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motors Co.*, 9 U.S.P.Q. 2(d) 1913, 1920 (Fed. Cir. 1989). The test for anticipation is - - - that which would literally infringe a claim if later in time, anticipates the claim if earlier than the date of the invention. *Lewmar Marine Inc. v. Barient, Inc.*, U.S.P.Q. 2(d) 1766 (Fed. Cir. 1987).

Specifically, Wilson does not show a first and second layer having light blocking regions and light passable regions distributed substantially throughout the layers. Wilson does not disclose light blocking regions since the layers of Wilson are either both translucent or the first layer is translucent and the second layer is clear. There is no teaching in the specification of Wilson that the layers include light blocking regions. Even if one argues that the non-translucent layer is opaque and not clear, the disclosed arrangement would only have one layer with light blocking regions and not two layers. Furthermore, there is no teaching in Wilson that the apertures shown at the corners of the Wilson panels are distributed substantially throughout the layers as required by claim 20. Thus, claim 20 is not anticipated or rendered obvious by Wilson.



Claims 21-25 are dependent upon claim 20. In light of the distinctions made in connection to claim 20, claims 21-25 are also not anticipated or rendered obvious by Wilson.

It is therefore requested that claims 1-28 be allowed and moved toward issuance.

Respectfully submitted,

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